

**REMARKS**

**STATUS OF THE CLAIMS**

Claims 1, 5-11, 14-16, 19, 22-24, 31, 32 and 34-37 are pending as shown above and claims 1, 7-11, 14-16, 19, 23, and 24 are under active examination.

**35 U.S.C. § 102(b)**

Claims 1, 7, 11, 14, 15, 19, and 24 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,980,550 (hereinafter “Eder”). (Office Action, page 2). Eder was cited for teaching coils that include an inner coating of fibrinogen. *Id.*

Applicant again traverses the rejection and supporting remarks.

Anticipation is a rigorous standard – every limitation of the claim at issue must appear identically in a single reference for a rejection under 35 U.S.C. § 102 to stand. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Therefore, in the instant case, Eder must identically disclose a vaso-occlusive device consisting of a vaso-occlusive member and a bioactive material selected from the group consisting of fibrin; polyethylene glycol derivatives; thrombin-coated gelatin granules; balloons coated with iron microspheres; trace metals; thrombus-stabilizing molecules; and combinations thereof.

As a threshold matter, Applicants note that this reference was previously addressed during prosecution (see, e.g., Response filed March 31, 2003) and overcome because Eder fails to anticipate any of the currently pending claims.

First, Eder fails to anticipate the pending claims because fibrinogen (as disclosed in Eder) is not fibrin, as recited in the pending claims. It is well known to the skilled artisan that fibrinogen is a precursor of fibrin (fibrin is made from fibrinogen in the presence of thrombin). Thus, fibrin and fibrinogen as disclosed in Eder are not the same and, on this basis alone, this reference does not anticipate the pending claims.

Second, Eder fails to anticipate the pending claims because his devices do not consist of the recited elements. As previously noted, it is well settled that claims including fewer elements than contained in the reference are not anticipated by that reference. *See, e.g., Kalman v. Kimberly-Clark Corp.* 218 USPQ 781 (Fed. Cir. 1983), *cert. denied*, 484 US 1007 (1988). Here, the claims use the closed transition language “consisting of.” Therefore, the pending claims are

necessarily limited to the elements listed in the claims and, as such, necessarily **exclude** a water-soluble coating over top of the inner coating (e.g. fibrinogen), as required by Eder. Accordingly, the claimed compositions and methods always include fewer elements than contained in Eder and, as such, Eder cannot anticipate any of the pending claims.

### **35 U.S.C. § 103**

#### **A. Claims 8-10 and 23**

Claims 8 to 10 and 23 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Eder in view of U.S. Patent No. 4,414,976 (hereinafter "Schwarz"). (Office Action, page 3). Eder was cited as above for a vaso-occlusive coil that is used with fibrinogen, while Schwarz was cited for teaching that a surgical tissue adhesive can be made with Factor XIII, plasminogen activator or plasmin inhibitor in order to stimulate wound healing. *Id.* It was alleged that it would have been obvious to provide the device of Eder with the tissue adhesive of Schwarz in order to promote wound healing. *Id.*

For the reasons detailed above, Eder fails to teach or suggest the claimed devices. In fact, Eder teaches away from occlusive compositions consisting of the recited elements. Indeed, the previous rejections based Eder were withdrawn years ago by the Office because this reference teaches away from the claimed occlusive compositions. For its part, Schwarz is completely silent as to coils or vessel occlusion, disclosing instead a tissue adhesive comprising fibrinogen and Factor XIII to "seamlessly connecting tissue or organ parts, for sealing wounds, stopping bleeding and stimulating wound healing in mammals." *See*, claim 1 of Schwarz.

Thus, there is no combination of Eder and Schwarz that teaches or suggests the claimed subject matter and withdrawal of the rejection is in order.

#### **B. Claim 16**

Claim 16 was rejected as allegedly obvious over Eder in view of U.S. Patent No. 6,526,979 (hereinafter "Nikolchev"). (Office Action, pages 3-4). Schwarz was cited as above and Nikolchev was cited for teaching microtexturing. *Id.*

For the reasons listed above, Eder does not teach or suggest the compositions of claim 16 and, therefore, the rejection is untenable.


**CONCLUSION**

For the reasons discussed above, Applicants submit that the claims are in condition for allowance and request early notification to that effect.

If the Examiner has any further issues or wishes to discuss any of the foregoing, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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